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In re Application of
Dyck et al.

Application No.: 09/646,110

PCT No.: PCT/CA99/00250

Int. Filing Date: 25 March 1999

Priority Date: 26 March 1998

Attorney's Docket No.: 10242-034

For: ALIPHATIC AMINO CARBOXYLIC AND
AMINO PHOSPHONIC ACIDS, AMINO NITRILES
AND AMINO TETRAZOLES AS CELLULAR
RESCUE AGENTS

DECISION ON

RENEWED REQUEST

UNDER 37 CFR 1.42

This decision is in response to the "Renewed Request Under 37 CFR 1.42" filed 05 November 2001.

BACKGROUND

On 25 March 1999, applicants filed international application PCT/CA99/00250, which claimed priority of two earlier United States provisional applications filed 26 March 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 September 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 14 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 26 September 2000.

On 26 September 2000, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 13 November 2000, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a surcharge fee.

On 16 January 2001, applicants filed executed declarations for inventors Dyck, Davis, Liu, Durden and Bouton. Since inventor Paterson is deceased, applicants filed a declaration executed by his legal representative, The Canada Trust Company as well as the Letter Probate of the Last Will and Testament. Applicants also filed an assignment, a power of attorney executed by the inventors and the legal representative for Mr. Paterson, a petition and the fee for a one-month extension of time, and the Initial Information Data Sheet.

On 01 February 2001, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) and the "NOTIFICATION OF DEFECTIVE OATH OR DECLARATION" (Form PCT/DO/EO/917) indicating that the declaration did not comply with 37 C.F.R. 1.497(a) and (b) and 37 CFR 1.63.

On 26 February 2001, applicants filed a response indicating that the Declaration submitted on January 12, 2001 does comply with 37 CFR 1.63 since an Initial Application Data Sheet was also submitted. This response was treated as a request under 37 CFR 1.42.

On 05 July 2001, the request under 37 CFR 1.42 was dismissed for failure to identify the correct inventive entity as required under 37 CFR 1.497(a)(3).

On 05 November 2001, applicant filed the current response, which includes 3 new complete declarations and affidavits from the representatives of The Canadian Trust.

DISCUSSION

With respect to applicants' declarations in the current application, 37 CFR 1.42 states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497 states, in part:

(a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to 1.494 or 1.495, he or she must file an

oath or declaration that:

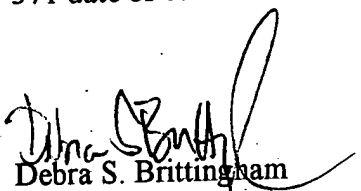
- (1) Is executed in accordance with either 1.66 or 1.68;
 - (2) Identifies the specification to which it is directed;
 - (3) Identifies each inventor and the country of citizenship of each inventor; and
 - (4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
- (b) (1) The oath or declaration must be made by all of the actual inventors except as provided for in 1.42, 1.43 or 1.47.
- (2) If the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, the facts required by 1.42, 1.43 or 1.47, and, upon information and belief, the facts which the inventor would have been required to state.

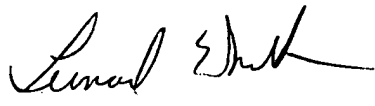
The declarations filed with the current response indicate the mailing address of the legal representatives, as well as the last address of the deceased inventor, as required under 37 CFR 1.497(b)(2). Further, the current response includes affidavits indicating that Brenda Kennedy and Kevin Rogers have the authority to sign on behalf of the legal representative, Canada Trust. Accordingly, the declarations filed with the current response are acceptable under 37 CFR 1.497.

CONCLUSION

Applicants' request under 37 CFR 1.42 is GRANTED.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision; and, if appropriate, a Notification of Acceptance of Application (Form PCT/DO/EO/903) will be mailed showing a 35 U.S.C. 371 date of 05 November 2001.


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